



Docket No.: 1075.1167

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Satoshi IWATA et al.

Serial No. 09/862,448

Group Art Unit: 2178

Confirmation No. 8881

Filed: May 23, 2001

Examiner: Campbell, Joshua D.

For: DISPLAY APPARATUS, AND COMPUTER-READABLE RECORDING MEDIUM IN
WHICH DISPLAY CONTROL PROGRAM IS RECORDED

APPELLANT'S BRIEF IN REPLY UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief-Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed July 24, 2008 in the above-identified application, Appellants submit this Reply Brief.

In Response to section (10) Response to Arguments of the Examiner's Answer

I. In the Appeal Brief, relative to claim 1, Appellants argued (B1) that Enzo and Palmer alone or in combination do not render obvious "a partially displaying mode in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition" as recited in independent claim 1 amended on April 9, 2007. (See B.1 on pages 5-6 of the Appeal Brief.)

In response to the Appellants' argument B1, the Examiner speculates that the Appellant's argument is based on a certain interpretation of the term "portion," which he argues does not conform to particular embodiments and statements in the specification. Appellants respectfully submit that it has been well established that the pending claims must be "given their broadest reasonable interpretation consistent with the specification." (See the Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).) Additionally it is also recognize that it is improper to import claim limitations from the specification: "Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004). See also *Liebel-Flarsheim Co. v. Medrad Inc.*, 358 F.3d 898, 906, 69 USPQ2d 1801, 1807 (Fed. Cir. 2004).

U.S. Patent No. 6,002,798 to Palmer et al. ("Palmer") does not disclose any mode in which only a portion of each page extracted according to a predetermined condition is displayed.

In the "Summary of the claimed subject matter" of the appeal brief, Appellants have identified FIGS. 16, 18, 20, 22 and 23 of the specification and the corresponding description in the specification as being relevant to the partially displaying mode, in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition. Further elaborating, Appellants direct attention to FIG. 16 of the specification where the automatic paging 1 mode and the automatic paging 2 mode are modes in which only text with font size exceeding a certain size (F1 or F2) is displayed. Further, in FIG. 17 step S133 states "REFER TO CHARACTER DATA & EXTRACT FONT TYPE", and then S23 and S26 state "DISPLAY ACCORDING TO DISPLAY METHOD 1" or "DISPLAY ACCORDING TO DISPLAY METHOD 2" respectively. In

contrast S22 states "DISPLAY CONTENTS CORRESPONDING TO ONE PAGE". Thus, maintain that Palmer's different levels of abstraction according to which documents are always displayed within the structural view of **the whole page**, do not anticipate or render obvious displaying "a portion of each page [...] extracted according to a predetermined condition."

The Examiner's position that all the modes display the contents corresponding to one page is an overly narrow and incorrect interpretation based on instances from the specification which are not intended to limit to the claim language. In contrast, the specification includes disclosure which supports the Appellants' interpretation of the term "portion" consistent with the plain meaning (i.e. a portion is not a "whole").

II. In the Appeal Brief, relative to claims 5 and 6, Appellants argued (B2) that Enzo and Palmer alone or in combination do not render obvious that the predetermined condition used in the partially displaying mode to extract the displayed portion, "involves a font size" or a "font type." (See B.2 on pages 6 of the Appeal Brief.)

In response to the Appellants' argument B2 the Examiner argues that although in Palmer the selection is based on the region type (i.e. "Title", "Full text") since font attributes of these regions are known Palmer's selection "involves" font type and size. Appellants respectfully submit that since Palmer does not teach or suggests that "Titles" regions and "Full text" regions are selected identified based on font sizes or font types, the selection of the regions to be displayed do not involve the font characteristics even if the font characteristics are known. Thus, Palmer does not explicitly or inherently renders obvious the features recited in claims 5 and 6.

III. In the Appeal Brief, Appellants argued that the Examiner failed to provide a motivation to combine the teachings of Enzo and Palmer, the Examiner cites a new portion of Palmer (col. 2, lines 34-39) as allegedly providing the required motivation. However, the indicated portion merely states the objectives achieved by Palmer's invention without any reason to combinate Palmer's teachings with Enzo's teachings. Therefore, Appellants respectfully submit that the Examiner failed to establish "an apparent reason to combine ... known elements." (*KSR Int'l. v. Teleflex* (2007), at page 4).

CONTINGENT AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND

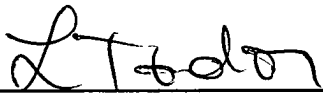
CONTINGENT PETITION FOR EXTENSION OF TIME

Appellants hereby petition for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-3935.

Respectfully submitted,

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Date: Sept. 24, 2008

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